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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,427	07/10/2003	David M. Van Wie	7451 0002-04	5616
22852	7590	10/14/2009		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER JOHNSON, CARLTON	
			ART UNIT	PAPER NUMBER
			2436	
			MAIL DATE	DELIVERY MODE
			10/14/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/618,427

**Applicant(s)**

VAN WIE ET AL.

**Examiner**

CARLTON V. JOHNSON

**Art Unit**

2436

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 38, 40 and 41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 38, 40 and 41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 7-24-2009 has been entered.

2. Claims **38, 40, 41** are pending. Claims **1 - 37, 39, 43 - 53** have been canceled. Claim **38** is amended. Claim **38** is independent. This application was filed on 12-20-2002.

### ***Response to Arguments***

3. Applicant's arguments have been fully considered but they are moot based on a new ground of rejection.

3.1 Applicant argues that the referenced prior art does not disclose, *control information intertwined with content*. (see Remarks Page 5)

Cooperman prior art discloses control information such as a copyright certificate (control information) that is embedded within content. (see Cooperman col. 5, lines 30-

34: hide a securely encrypted digital copyright certificate to be integral with the content;  
col. 5, lines:13-30)

***Claim Rejections – 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims **38, 40, 41** are rejected under 35 U.S.C. 103 (a) as being unpatentable over **Moskowitz et al.** (US Patent No. **5,889,868**) in view of **Stefik et al.** (US Patent No. **5,629,980**) and further in view of **Cooperman et al.** (US Patent No. **5,613,004**).

**With Regards to Claim 38**, Moskowitz discloses a rights management method comprising the steps of:

- (a) receiving an information signal at a first device, the information signal comprising a content portion and steganographically encoded control information, the control information comprising an indication of whether at least part of the content portion may be copied; (see Moskowitz col. 10, lines 15-18: signal includes watermark (control information))
- (b) steganographically decoding the received information signal to recover the control information; (see Moskowitz col. 3, lines 18-22: decode watermark

(control information) from signal)

Moskowitz discloses control information and a content signal. (see Moskowitz col. 3, lines 18-22: carry watermark control information carried in content signal)

Moskowitz does not specifically disclose copying the content.

However, Stefik discloses:

- (c) using the control information to determine whether at least part of the information signal may be copied to a second device; (see Stefik col. 34, lines 34-40: request to make one or more copies of the work (information signal, content); make copies with the same or lesser usage rights (control information);) and
- (d) copying at least part of the information signal to the second device if permitted by the control information. (see Stefik col. 34, lines 34-40: request to make one or more copies of the work (information signal, content); col. 34, lines 54-61: server transmits the requested contents and data to the client (second device); rights are transmitted)

It would have been obvious to one of ordinary skill in the art to modify Moskowitz for copying the content as taught by Stefik. One of ordinary skill in the art would have been motivated to employ the teachings of Stefik in order to enable the capability for a distribution system where the means for billing is always transported with the work. (see Stefik col. 3, lines 45-47)

Moskowitz discloses steganographic methods for the insertion of information such as identifying the title, copyright holder, or a myriad of other information such as a

number of copies allowed parameter. (see Moskowitz col. 5, lines 59-66: steganographic methods for insertion of information)

Moskowitz does not specifically disclose a number of times the content may be rendered and rendering the content on a first device.

However, Stefik discloses wherein further comprising an indication of a number of times the content portion may be rendered by a given device. (see Stefik col 37, lines 18-22: number of copies in the (print) request (number of times content may be rendered or printed by a device (a given device))

And, Stefik discloses the following:

- e) using the control information to determine whether the content portion may be rendered by the first device; (see Stefik col. 30, line 59 - col. 31, line 4: each usage may have one or more conditions which must be satisfied before the right can be exercised; verify that requirements are met for all of the parts involved in a transaction) and
- f) rendering the content on the first device if permitted by the control information. (see Stefik col. 36, lines 29-32: send the digital work through some kind of transducer or a display device)

It would have been obvious to one of ordinary skill in the art to modify Moskowitz for an indication of a number of times the content portion may be rendered by a given device and for rendering on an audio output and not rendering on an audio output as taught by Stefik. One of ordinary skill in the art would have been motivated to employ the teachings of Stefik in order to enable the capability for

a distribution system where the means for billing is always transported with the work.  
(see Stefik col. 3, lines 45-47)

Moskowitz does not specifically disclose control information intertwined with content. However, Cooperman discloses control information being intertwined with the content portion of the information signal. (see Cooperman col. 5, lines 30-34: hide a securely encrypted digital copyright certificate to be integral with the content; col. 5, lines:13-30)

It would have been obvious to one of ordinary skill in the art to modify Moskowitz for control information intertwined with content portion as taught by Cooperman. One of ordinary skill in the art would have been motivated to employ the teachings of Cooperman to watermark content in such a way which does not impact perception significantly but makes it difficult to defeat. (see Cooperman col. 5, lines 60-66)

**With Regards to Claim 40**, Moskowitz discloses an information signal as in claims 30, 38, wherein comprising control information. (see Moskowitz col. 3, lines 18-22: carry watermark control information carried in content signal) Moskowitz does not specifically disclose content may only be copied to appliances capable of enforcing the control information. However, Stefik discloses wherein an indication that the content may be copied only to appliances capable of enforcing the control information. (see Stefik col. 3, lines 59-60: digital works may only be accessed by other secure repositories)

It would have been obvious to one of ordinary skill in the art to modify Moskowitz

whereby content is copied only to appliances that are capable of enforcing the control information as taught by Stefik. One of ordinary skill in the art would have been motivated to employ the teachings of Stefik in order to enable the capability for a distribution system where the means for billing is always transported with the work. (see Stefik col. 3, lines 45-47)

**With Regards to Claim 41**, Moskowitz discloses an information signal as in claims 30, 38, in which the control information. (see Moskowitz col. 3, lines 18-22: carry watermark control information carried in content signal) Moskowitz does not specifically disclose an expiration date. However, Stefik discloses wherein comprising an expiration date after which the electronic content cannot be used. (see Stefik col 49, ll 55-57: expiration time period for usage rights)

It would have been obvious to one of ordinary skill in the art to modify Moskowitz for an expiration date after which the electronic content cannot be used as taught by Stefik. One of ordinary skill in the art would have been motivated to employ the teachings of Stefik in order to enable the capability for a distribution system where the means for billing is always transported with the work. (see Stefik col. 3, lines 45-47)

**With Regards to Claim 42**, Moskowitz discloses an information signal as in claim 38, in which the control information is intertwined with the electronic content. (see Moskowitz col. 10, lines 15-18: watermark (information control signal) integrated (intertwined) with content signal (electronic content))



### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlton V. Johnson whose telephone number is 571-270-1032. The examiner can normally be reached on Monday thru Friday , 8:00 - 5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nasser G Moazzami/  
Supervisory Patent Examiner, Art Unit 2436

Carlton V. Johnson  
Examiner  
Art Unit 2436

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October 1, 2009